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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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057-444, 111 01/18/00 000174

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WILLIAM A. VANDERKAM
1000 WILKINS BLVD. SE
8TH FLOOR
ATLANTA, GA 30316-4774

WILLIAM A. VANDERKAM

EXAMINER

01/18

ART UNIT	PAPER NUMBER
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2882

DATE MAILED:

01/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/664,443

Applicant(s)

GREEN ET AL.

Examiner

Nguyen T Vo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 09/18/2000 has been considered and made of record by the examiner.

Specification

2. The disclosure is objected to because the continuation information on page 1 is in error. According to the continuation information on page 1, the present application is (i) a continuation of application 09/001,484 and (ii) continuation-in-part of application 08/838,677. Since the specification of the present application is **not identical** to that of application 09/001,484, the present application is **not** a continuation of application 09/001,484. Since the specification of the present application is **identical** to that of application 08/838,677 (see applicant's preliminary amendment filed 09/18/2000, page 7), the present application is **not** a continuation-in-part of application 08/838,677.

Since the continuation information is not correct, the present application does not benefit the earlier filing dates of the prior applications.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,805,975. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 of U.S. Patent No. 5,805,975 encompass claims 1, 7-12 of the present application.

5. Claims 1, 7-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,122,482. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-39 of U.S. Patent No. 6,122,482 encompass claims 1, 7-12 of the present application.

Claim Rejections - 35 USC § 112

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 7, "plurality" at line 9 should be changed to -polarity--.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 7-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 1, the original specification fails to disclose the claimed limitations “the first frequency converter converting at least a first **plurality of television program signals**”, “a second **plurality of television program signals**”, “the second frequency converter further converting said **converted first plurality of television signals**”, and “wherein all of the television program signals within the first plurality of television program signals are received by the satellite dish with a common polarization” as claimed.

As to claim 7, the original specification fails to disclose the claimed limitations “**block** converter that frequency-converts a **channel block**”, “said switch operating to select between said frequency-converted **channel block** and at least one further **channel block**” as claimed.

As to claims 8-12, they are rejected for the reasons as set forth in claim 7.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uemura (Japanese Publication No. 2-140022).

As to claim 1, Uemura discloses in figure 1 a satellite broadcasting system comprising a satellite dish 1 for receiving vertical and horizontal polarized signals, a first frequency converter (see numerals 3-4), a single cable (see the transmission line 13), a second frequency converter 43 (see figure 3). Uemura thus discloses all the claimed limitations except for the cable 13 being a coaxial cable. The examiner, however, takes Official Notice that such a coaxial cable is known in the art for having a larger bandwidth. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the cable 13 in Uemura with the conventional coaxial cable, in order to achieve more bandwidth.

Conclusion

12. Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

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or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Nguyen Vo, whose telephone number is (703) 308-6728. The
Examiner can normally be reached on Tuesday-Friday from 8:00 AM - 5:30 PM. The examiner
can also be reached on alternate Monday.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703) 305-3900.

Nguyen Vo

March 10, 2001



NGUYEN T. VO
PRIMARY EXAMINER